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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,568	01/14/2004	Michiaki Omura	P/1929-91	5922
2352 7590 04/09/2008 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
KEEFEER, MICHAEL E				
ART UNIT		PAPER NUMBER		
2154				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,568

Applicant(s)

OMURA, MICHIAKI

Examiner

MICHAEL E. KEEFER

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 2/8/2008.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed 2/8/2008. Claims 1-9 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of McConnell et al. (US 2002/0015403), hereafter McConnell.

Regarding **claims 1-3**, AAPA discloses:

A gateway for connecting networks of different types, for connecting a first network and a second network which uses a signal format different from that of the first network, said gateway comprising:

a conversion section which converts a signal used in the first network to a signal to be used in the second network, and a signal used in the second network to a signal to be used in the first network, when communication is performed between a terminal connected to the first network and a terminal connected to the second network; (page 1, lines 26-33 discloses a gateway which converts signals between two networks)

a detection section which detects conversion-process information containing at least one of the time said conversion section spent to convert the signal and the amount of data converted; and

a network connecting section which is connected to at least one of the first and second networks and which transmits the conversion-process information to a fee-charging system of the first network or a fee-charging system of the second network. (page 1, lines 26-33 disclose that there is a network connecting section in a gateway)

wherein said conversion section converts at least one of a call-control signal generated by call-connection signaling, an audio signal generated by an audio CODEC and a video signal 25 generated by a video CODEC. (Page 2 lines 2-10 disclose a gateway converting control, audio and video signals)

wherein said conversion section comprises a signaling gateway unit which converts the call-control signal and a media gateway unit which converts the audio signal and the video signal, wherein said detecting section detects the conversion-process information used in a conversion process in the media gateway unit. (Page 2 lines 2-10 disclose a gateway converting control, audio and video signals)

Regarding **claims 5-7**, AAPA discloses:

A system for charging fees for communication between networks of different types, said system comprising:

a first terminal which performs a call control; (a first terminal is inherent in the communications described on page 2 lines 2-10.)

a second terminal which responds to the call control performed by the first terminal; (a second terminal is inherent in the communications described on page 2 lines 2-10.)

a first network to which the first terminal is connected; (Page 1 lines 13-25 discloses a first network)

a second network to which the second terminal is connected; and (Page 1 lines 13-25 discloses a second network)

a gateway which connects the first network and the second network, (page 1, lines 26-33 discloses a gateway which converts signals between two networks)

wherein:

the first network and the second network use different signal formats; (Page 1 lines 13-25 discloses that the network use different signals)

the first network comprises a fee-charging system;

the gateway converts a signal from the first network to a suitable signal for the signal format of the second network and transmits the signal to the second network, converts a signal from the second network to a suitable signal for the signal format of the first network and transmits the signal to the first network, detects conversion-process information containing at least one of the time spent

to convert the signal and the amount of data converted, and (page 1, lines 26-33 discloses a gateway which converts signals between two networks)

transmits the conversion-process information to the fee-charging system, in order to accomplish communication between the first terminal and the second terminal; and the fee-charging system performs a fee-charging process in accordance with the conversion-process information, to charge a fee on a user of the first terminal.

wherein the gateway detects the conversion-process information after the first terminal and the second terminal have been connected to each other.

wherein the gateway detects the conversion-process information about at least one of a signal generated by an audio CODEC and a signal generated by a video CODEC. (converting audio and video signals is disclosed on page 2 lines 2-10.)

Regarding **claims 8-9**, AAPA discloses:

A method of charging fees for communication between networks of different types, comprising the steps of: connecting a first network and a second network using a signal format different from that of the first network, by means of a gateway which converts a communication signal from a first terminal connected to the first network, to a suitable signal for the signal format of the second network and converts a communication signal from a second terminal connected to the second terminal, to a suitable signal for the signal format of the first network; detecting conversion-process information containing at least One of the

time spent to convert a signal and the amount of data converted, said signal having been transmitted after the first terminal and the second terminal have been connected to each other, by the gateway; transmitting the conversion-process information to a fee-charging system of the network to which the first or second terminal that is a calling side is connected, by the gateway; and charging a fee on a user of the calling-side terminal, said fee being fixed or calculated on the basis of communication 5 time, based on the conversion-process information, by the fee-charging system. (Page 1 lines 13-32 disclose the networks and the gateway, page 2 lines 2-10 disclose the conversion of audio, video and call signaling by the gateway)

wherein the conversion-process information includes at least one of the time spent to convert signals in an audio CODEC and video CODEC and the amount of data converted therein (Page 2 lines 2-10 disclose a gateway converting control, audio and video signals).

AAPA discloses all of the limitations of claims 1-3 and 5-9 except for detecting conversion-information, and a fee-charging system.

McConnell teaches a gateway which includes a detecting system and billing interface to interact with billing servers. [0185] teaches the gathering of extensive billing data, including the amount of data downloaded (i.e. converted) and the amount of time taken for the download of content (i.e. the conversion of content). Various billing (fee-charging) systems are sent this information ([0187] teaches that the data can be presented to the operator's billing system.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine AAPA with the gateway system of McConnell in order to allow a range of services to be provided in a versatile manner.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA and McConnell as applied to claims 1-3 above, and further in view of Agrawal et al. (US 2001/0046234), hereafter Agrawal in further view of Jabri (US 2003/0027643).

AAPA and McConnell teach all the limitations of claim 4 except for the specific conversions of Q.931 to SIP, AMR to G.723.1, and MPEG4 to H.263.

The general concept of converting H.323 (which inherently includes Q.931 signalling) to SIP signaling is well known in the art as taught by Agrawal. (See abstract)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify AAPA and McConnell with the general concept of converting H.323 (which inherently includes Q.931 signalling) to SIP signaling as taught by Agrawal in order to allow interworking function including a state machine for interworking between two dissimilar protocols.

AAPA, McConnell, and Agrawal teach all the limitations of claim 4 except for the specific conversions of AMR to G.723.1 and MPEG4 to H.263.

The general concept of converting AMR to G.723.1 and MPEG4 to H.263 is well known in the art as taught by Jabri. ([0014] lines 2-5)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify AAPA, McConnell and Agrawal with the general concept of

converting AMR to G.723.1 and MPEG4 to H.263 as taught by Jabri in order to increase the versatility of the system.

Response to Arguments

4. Applicant's arguments filed 2/8/2008 have been fully considered but they are not persuasive.

5. Applicant appears to argue that the combination of Applicant's Prior Art and McConnell does not make obvious claims 1-3 and 5-9, by arguing that McConnell does not teach the limitations that Applicant's Admitted Prior Art teach, and vice versa. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

However, the Examiner will clarify his reasoning, to expedite prosecution of the case. The Examiner asserts that the essential network architecture (two networks of different types coupled by a conversion entity) is taught by Applicant's Admitted Prior Art. (See the above rejection for details where each limitation may be found.) The Examiner admits, as Applicant had noted, that AAPA does not disclose gathering billing type information, or charging fees. The Examiner asserts specifically the combination of McConnells information gathering and billing teachings (at least para. 185 and 187 as previously and currently cited) with the gateway/converter disclosed by AAPA. Any content being downloaded through the gateway must be converted in the network architecture disclosed by AAPA, therefore, McConnell's tracking of the amount of data

downloaded and the time it takes to download data would include the amount of time required to convert the data as it traveled between the networks as part of the total time it would take or amount of data sent.

Applicant argues, in substance, that McConnell does not disclose a conversion section converting ...as described in claim 2. The Examiner agrees. This limitation was not cited as teaching this particular limitation, rather AAPA discloses the conversion step as described in the rejections above.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL E. KEEFER whose telephone number is (571)270-1591. The examiner can normally be reached on Monday through Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

4/3/2008

/Joseph E. Avellino/
Primary Examiner, Art Unit 2146